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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,594	08/29/2001	Taminori Tomita	ASA-1029	5019
24956	7590	02/25/2005	EXAMINER	
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.			DAVIS, ZACHARY A	
1800 DIAGONAL ROAD				
SUITE 370			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	
			2137	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,594

Applicant(s)

TOMITA ET AL.

Examiner

Zachary A Davis

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20010829</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 08 May 2001. It is noted, however, that applicant has not filed a certified copy of the Japanese application (2001-136827) as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. The information disclosure statement filed 29 August 2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a translation or concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent or document listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. It is further noted that non-patent references AR and AS are referred to only by titles, and do not include other relevant information such as author (if available), publisher, date, and pertinent pages.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-6 and 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "information on the digital signature which is put on said input digital signature data". This limitation renders the claim indefinite because it is not clear exactly how the information is "put on" the digital signature data.

In reference to Claims 3 and 9, the limitation "a subject putting said digital signature" is generally unclear, as it is not clear where or on what the digital signature is put.

Claims 5 and 11 recite the limitations "the information representing the content of said partial data" and "the other information". There is insufficient antecedent basis for these limitations in the claims.

Claim 6 recites the limitation "said means for detecting points a predetermined data retrieves an identifier prescribed in XML and detects based upon said retrieved identifier". This limitation is generally vague, as it is unclear what is retrieving or detecting. Further, more specifically, it is unclear exactly how the predetermined data is pointed.

Claim 8 recites the limitation "information on the digital signature being put on said input digital signature data". This limitation renders the claim indefinite because it is not clear exactly how the information is "put on" the digital signature data.

Claim 12 recites the limitation "said means for detecting points a predetermined data". This limitation renders the claim indefinite, as it is unclear exactly how the predetermined data is pointed.

Claim 13 recites the limitation "the partial data" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim. Further, the limitation "the partial data being put said digital signature and said identifier" is generally vague.

Claims 4, 10, and 14 are rejected due to their dependence on a rejected base claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al, US Patent 6671805.

In reference to Claim 1, Brown discloses an apparatus including a means for inputting digital signature data (column 13, lines 22-27; column 8, line 57-column 9, line 30), means for detecting the range of a part of data that is signed (column 8, lines 35-47), and a means for displaying the content of the detected data (Figure 2, Display Device 208; column 14, lines 46-49).

In reference to Claims 2 and 3, Brown further discloses detecting information on the digital signature, which describes the signer, and displaying that information (column 14, lines 46-49).

In reference to Claims 4 and 5, Brown further discloses that the part of the data which is signed is displayed (column 11, line 65-column 12, line 13; column 13, lines 13-21; column 14, lines 46-62).

In reference to Claim 6, Brown further discloses that the signature is described in XML (column 7, lines 39-45; column 14, lines 11-17).

Claims 7-12 are directed to a software implementation of the apparatus of Claims 1-6, and are rejected by a similar rationale.

In reference to Claim 13, Brown discloses an apparatus that includes a memory unit (Figure 2, Storage Device 204) and a processing unit (Figure 2, CPU 202) that generates a partial digital signature (column 8, line 57-column 9, line 30) and an identifier to specify the part of the data signed (column 8, lines 35-47).

In reference to Claim 14, Brown further discloses a network connection unit (Figure 2, Network Interface 206).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. Fischer, US Patent 5214702, discloses a system that includes a digital signature appended to the data that is signed (see Figure 8).
 - b. Matsumoto et al, US Patent 5465299, discloses a system for updating digital signatures.
 - c. Romney et al, US Patent 5872848, discloses a system for witnessing digital signatures that includes affixing signature and certificate information to the data signed (see Figures 9-1 to 9-3).
 - d. Holloway et al, US Patent 5912974, discloses a method for authenticating documents that includes digital signatures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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zad



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER